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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JANET K. O'GRADY,  
MAUREEN SULLIVAN MORRISSEY,  
ALEXANDER NOVIKOV,  
and  
RONALD McLAUGHLIN,  
Appellants<sup>1</sup>

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Appeal 2010-002959  
Application 10/719,224  
Technology Center 1600

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Decided: June 08, 2010

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Before CAROL A. SPIEGEL, TONI R. SCHEINER, and  
FRANCISCO C. PRATS, *Administrative Patent Judges*.

SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from an Examiner's final rejection of claims 1-6 and 22-32 (Br. 2; Ans. 2). Claims 11-21, the only other pending claims, stand withdrawn from consideration as directed to a

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<sup>1</sup> The real party in interest is THE PROCTER & GAMBLE COMPANY OF CINCINNATI, OHIO (Corrected Appeal Brief filed 19 May 2009 ("Br.") at 1). This decision also cites to the Examiner's Answer mailed 17 September 2009 ("Ans.").

nonelected invention (*id.*). We have jurisdiction under 35 U.S.C. § 134. We AFFIRM.

The subject matter on appeal is directed to shaving gel compositions comprising (1) vitamin A, (2) vitamin E, (3) aloe, and (4) at least one of bisabolol, panthenol (vitamin B<sub>5</sub>), vitamin B<sub>3</sub> (niacin), and vitamin C, each in an amount between about 0.001 and about 5 weight %.<sup>2</sup> The shaving gel compositions may be used alone or in combination with an aftershave gel, a moisturizing lotion, or a cleansing wash or bar composition which also contains one of ingredients (1)-(4). Claims 1 and 24 are illustrative and read (Br. 9-10):

1. A topical cosmetic composition for providing noticeably healthy looking human skin comprising a topical cosmetic carrier vehicle including vitamin A, vitamin E, aloe, and at least one member selected from the group consisting of bisabolol, panthenol, vitamin B<sub>3</sub> and vitamin C, wherein said vitamin A, said vitamin E, said aloe, and said at least one member are each independently included in an amount of about 0.001% to about 5% by weight of the composition, wherein the topical cosmetic composition is in the form of a shaving gel and further comprises a lathering agent, a foaming agent, and/or a self-foaming agent.

24. An array of topical cosmetic compositions for combined application to human skin, the array comprising:

- a) a first topical cosmetic composition in accordance with claim 1; and
- b) a second topical cosmetic composition selected from the group consisting of an aftershave

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<sup>2</sup> This decision uses the terms "weight %" and "%" interchangeably.

gel, a moisturizing lotion, a cleansing wash, and a  
cleansing bar,  
wherein the second topical cosmetic  
composition comprises vitamin A, vitamin E, aloe,  
bisabolol, panthenol, vitamin B<sub>3</sub> and/or vitamin C.

The Examiner has rejected claims 1-6 and 22-32 as unpatentable  
under 35 U.S.C. § 103(a) over the combined teachings of Stoner,<sup>3</sup> Fike,<sup>4</sup> and  
Lisboa<sup>5</sup> (Ans. 2-4).<sup>6</sup>

The Examiner found that Stoner teaches a treatment using two  
compositions, a self-foaming shaving gel and an aftershave splash, lotion or  
gel (Ans. 5). The Examiner found that Stoner teaches that the self-foaming  
shaving gel contains a lathering agent and additives such as aloe, vitamin A  
palmitate, panthenol, vitamin E, and preservatives (*id.*). The Examiner also  
found that Stoner teaches that the aftershave splash, lotion or gel comprises a  
humectant and can contain a wide variety of other cosmetic ingredients (*id.*).  
According to the Examiner, Stoner differed from the claimed subject matter  
in (a) failing to teach a shaving gel composition having the claimed weight

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<sup>3</sup> U.S. Patent 5,902,574, *Shaving Preparation for Improved Shaving Comfort*,  
issued 11 May 1999 to Stoner et al. ("Stoner").

<sup>4</sup> U.S. Patent 5,612,382, *Composition for Percutaneous Absorption of  
Pharmaceutically Active Ingredients*, issued 18 March 1997 to Elmer A.  
Fike ("Fike").

<sup>5</sup> U.S. Patent 5,679,324, *Aerosol Foamable Fragrance Composition*, issued  
21 October 1997, to Lisboa et al. ("Lisboa").

<sup>6</sup> The Examiner has withdrawn the final rejection of claims 24-32 under 35  
U.S.C. § 112, first paragraph (written description), and has added claims 22  
and 23 to the final rejection of claims 1-6 and 24-32 under 35 U.S.C. §  
103(a). Appellants have not responded to the new rejection of claims 22 and  
23 under 35 U.S.C. § 103(a), despite having the ability to file a Reply Brief.  
Therefore, there is no apparent due process issue in deciding the appeal on  
the record before us.

percents of vitamin A, vitamin E, aloe, and at least one of bisabolol, panthenol, vitamin B<sub>3</sub>, and vitamin C, and (b) failing to teach an aftershave gel composition comprising vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B<sub>3</sub>, and/or vitamin C (*id.* at 6).

However, the Examiner found that Stoner Example 4 provided guidance regarding the amount of additives to add to a shaving gel composition (*id.* at 7). The Examiner also found that Fike teaches adding 0.1 to 15 weight % vitamin B<sub>3</sub> to compositions for delivering active ingredients through skin or mucosal tissues and that Lisboa teaches foamable fragrance compositions comprising about 0.01 to about 10 weight % bisabolol for use in the shaving gel art (*id.* at 5).

Thus, the Examiner concluded that it was "only a matter of judicious selection and routine optimization for one of ordinary skill in the art to add other additives, such as vitamins, in the amount taught by Stoner et al. to read on the amount instantly claimed" (*id.* at 7). The Examiner further concluded that it was similarly just a matter of judicious selection and routine optimization to produce a second composition comprising vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B<sub>3</sub> and/or vitamin C because all of these ingredients are taught by Stoner, Lisboa, and Fike for the same use, i.e., in topical skin compositions (*id.* at 7-8).

Appellants argue that none of the applied references teach or suggest the specific base mixture of vitamin A, vitamin E, and aloe, along with an additional material(s) selected from bisabolol, panthenol, vitamin B<sub>3</sub>, and vitamin C, required by claims 1 and 24 (Br. 6).

Appellants have not presented separate patentability arguments for any of claims 2-6, 22, 23 or 25-32. Therefore, we decide this appeal on the basis of claims 1 and 24. 37 C.F.R. § 41.37(c)(1)(vii).

Based on the respective positions of the Examiner and Appellants, the issues before us are whether the evidence of record supports the Examiner's conclusions that it would have been obvious

(1) to provide a shaving gel composition containing vitamin A, vitamin E, aloe, and at least one of bisabolol, panthenol, vitamin B<sub>3</sub>, and vitamin C in the amounts recited in claim 1; and,

(2) to provide the shaving gel composition of claim 1 in combination with an aftershave gel comprising vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B<sub>3</sub>, and/or vitamin C as recited in claim 24.

## II. Findings of Fact

The following findings of fact ("FF") are supported by a preponderance of the evidence of record.

### A. Stoner

- [1] Stoner teaches the sequential use of two compositions to provide improved shaving comfort (Stoner abstract; 1:12-17).
- [2] The first composition is a shaving composition comprising a reducing agent and the second composition is an aftershave composition comprising a humectant (Stoner 1:60-2:11).
- [3] The shaving composition comprises about 65 to 90% water, about 5 to 25% of a foaming agent, and about 0.2 to 2.3% of the reducing agent cysteamine (Stoner 2:37-41).
- [4] The shaving composition may also include other optional components, including humectants; emollients; skin freshening and soothing agents,

- such as aloe; lubricants; vitamins, such as panthenol, vitamin E, and vitamin A palmitate; colorants; fragrances; antioxidants; and, preservatives (Stoner 5:33-49).
- [5] Example 4 describes a non-soap self-foaming shave gel containing 74.75 wt.% water, 7.11 wt.% stearyl/myristoyl sarcosine, 4.33 wt.% oleth-20, 3.85 wt.% isopentane:isobutene (3:1), 2.69 wt.% myristyl alcohol, 2.60 wt.% triethanolamine, 1.92 wt.% mineral oil, 0.19 wt.% dimethethicone/dimethiconolol, 0.24 wt.% hydroxyethyl cellulose, 0.24 wt.% polyquaternium-10, 0.14 wt.% PEG-14M, 0.50 wt.% cysteamine, and q.s. fragrance/color/preservative (Stoner 11:1-17).
- [6] The aftershave composition is in the form of an aftershave splash, lotion or gel and typically comprises about 20 to 80% water, about 0 to 50% ethyl alcohol, about 5 to 50% humectant, fragrance, and optional thickening agent (Stoner 7:40-44).
- B. Fike
- [7] Fike discloses a composition for transdermally delivering pharmaceutically active ingredients into the body through skin or mucosal tissues (Fike abstract; 1:7-11; 2:49-51; 3:3-7).
- [8] The composition comprises the active ingredient(s) in admixture with a carrier comprising at least one hydroxy alkyl amide, preferably N-(2-hydroxyethyl) acetamide (Fike 3:3-7 and 37-38).
- [9] Exemplary active ingredients include vasodilators, such as derivatives of vitamin B<sub>3</sub> (Fike 4:15-37).
- [10] "Compositions using niacin, for example, may also be used as skin conditioners to soften, moisturize and reduce the flakiness of skin" (Fike 4:47-49).

- [11] For specific ailments, such as arthritis, split finger syndrome or hemorrhoidal tissues, the composition should comprise vitamin B<sub>3</sub> in an amount of from 0.1 to 15 percent by weight of the composition as the pharmaceutically active ingredient (Fike 4:57-5:1).

C. Lisboa

- [12] Lisboa discloses cosmetic aerosol foamable fragrance compositions which may contain additional ingredients to promote skin moisturization and conditioning (Lisboa 1:8-14).
- [13] The compositions comprise a surfactant, propellant, fragrance, and thickener (Lisboa 1:63-66).
- [14] Optional additional ingredients include medicaments and cosmetically active ingredients (Lisboa 6:12-23).
- [15] Exemplary cosmetically active ingredients are present at levels from about 0.1 to about 20% of the composition and include moisturizers/humectants, such as aloe vera (Lisboa 6:27-35 and 55-65).

III. Discussion

A. Legal principles

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and, (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Further, "the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take [into] account the inferences and creative steps that a person of

ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose." *In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980). "[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980).

#### B. Analysis

As to claim 1, Stoner teaches shaving gel compositions comprising aloe (a skin freshening and soothing agent), vitamins including A, E, and panthenol, and a foaming agent in an aqueous carrier (FF 3 and 4). Stoner does not expressly teach the weight % of aloe, vitamins A, E, or panthenol present in the shaving gel composition. However, Stoner provides general guidance for the composition of the shaving gel, i.e., about 65-90% water, about 5 to 25% foaming agent, and about 0.2 to 2.3% reducing agent, plus optional other components (FF 3 and 4), as well as specific exemplary shaving gel compositions. Example 4 of Stoner describes a shaving gel composition containing about 75% water, about 5 % foaming agent, about 0.5% reducing agent, and the remainder about ten optional components (FF 5). Thus, we agree with the Examiner that it would have been obvious to provide shaving gel compositions as taught by Stoner, including conventional additives, such as aloe and vitamins (including A, E, and panthenol), for their known benefits, such as skin freshening. We also agree

with the Examiner that the claimed % amounts of aloe, vitamin A, vitamin E, and panthenol would have been a matter of routine optimization well within ordinary skill in the art, especially given both the general guidance and specific Example 4 of Stoner. Moreover, Fike teaches both the skin conditioning properties of vitamin B<sub>3</sub> (FF 10) as well as its compatibility in compositions applied to the skin in amounts overlapping the claimed weight percent (FF 11). Similarly, Lisboa teaches both the skin conditioning (moisturizing) properties of aloe as well as its compatibility in compositions applied to the skin in amounts overlapping the claimed weight percent (FF 15). Thus, in our opinion, the subject matter of claim 1 would have been *prima facie* obvious from at least the teachings of Stoner and the teachings of Fike and Lisboa do not undermine the teachings of Stoner.

As to the array of claim 24, Stoner also teaches using its shaving gel compositions in combination with an aftershave gel (FF 1, 2, and 6). According to Stoner, the aftershave gel typically contains water, humectant, fragrance, and optional thickening agent (FF 6). Again, Lisboa teaches that aloe vera is a humectant as well as its compatibility in compositions applied to the skin (FF 15). Thus, in our opinion, the subject matter of claim 24 would have been *prima facie* obvious from at the teachings of the applied references.

### C. Conclusion

We will sustain the rejection of claims 1-6 and 22-32 under § 103(a) over Stoner, Fike, and Lisboa. The evidence of record supports the Examiner's conclusions that it would have been obvious (1) to provide a shaving gel composition containing vitamin A, vitamin E, aloe, and at least one of bisabolol, panthenol, vitamin B<sub>3</sub>, and vitamin C in the amounts

recited in claim 1; and, (2) to provide the shaving gel composition of claim 1 in combination with an aftershave gel comprising vitamin A, vitamin E, aloe, bisabolol, panthenol, vitamin B<sub>3</sub>, and/or vitamin C as recited in claim 24.

Appellants have not presented any evidence of secondary considerations of nonobviousness to persuade us otherwise.

IV. Order

Upon consideration of the record, and for the reasons given, it is  
ORDERED that the decision of the Examiner to reject claims 1-6 and 22-32 as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Stoner, Fike, and Lisboa is AFFIRMED, and

FURTHER ORDERED that no time period for taking any subsequent action in connection with the appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

alw

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